Attorney Docket No.: 5753.204-US PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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GROUP 1600

In re Application of: Nielsen et al. Confirmation No:

Serial No.: 09/831,656 Group Art Unit: To Be Assigned

Filed: May 11, 2001 Examiner: To Be Assigned

For: Transgenic Plant Expressing Maltogenic Alpha-Amylase

**CERTIFICATE OF FACSIMILE TRANSMISSION**

OFFICIAL

Commissioner for Patents
Washington, DC 20231

Sir:

I hereby certify that the attached correspondence comprising:

1. Response to Restriction Requirement

was sent to the United States Patent and Trademark Office by telefax to the attention of Examiner To Be Assigned, fax number (703) 308-4242

Respectfully submitted,

Date: January 15, 2003

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#8 Election

Attorney Docket No.: 5753.204-US

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: Nielsen et al.

Confirmation No: 7015

Serial No.: 09/831,656

Group Art Unit: 1638

Filed: May 11, 2001

Examiner: Kallis

For: Transgenic Plant Expressing Maltogenic Alpha-Amylase

**RESPONSE TO RESTRICTION REQUIREMENT**

Commissioner for Patents
Washington, DC 20231

Sir:

This paper is filed in response to the Office Action mailed December 18, 2002 that made a restriction requirement. Applicants were requested to elect one of two designated groups.

In response to these requirements, Applicants hereby elect with traverse the invention of Group I, claims 23-37.

Applicant respectfully traverses this requirement. The above-captioned application was entered into the national stage under 35 U.S.C. 371, i.e. filed via the PCT. For these types of applications, the PTO follows the rules set forth in 37 C.F.R. 1.401 - 1.499.

The standard for determining whether unity of invention exists during the national stage, i.e. whether a restriction requirement may be imposed, is set forth in 37 C.F.R. 1.475(a) which provides:

> An international and a national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept.... Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression 'special technical features' shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

Moreover, under 37 C.F.R. 1.475(b), an international or a national stage application in the national stage complies with the unity of invention requirement if the claims are drawn only to one of the following combinations of categories:

> (1) A product and a process specially adapted for the manufacture of said product; or

(2) A product and a process of use of said product; or

(3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or

(4) A process and an apparatus or means specifically designed for carrying out the said process; or

(5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specially designed for carrying out the said process.

The basis for this traversal is that the Examiner applied an incorrect factual assessment of the contribution which each of the claimed inventions, considered as a whole, makes over the prior art, and the relationship between each of the claimed inventions.

Foremost, the Examiner's statement that the inventions of Group I and Group II do not constitute an advance in the prior art over WO 91/14772 is incorrect. WO 91/14772 does not reference a maltogenic alpha-amylase, let alone, a transgenic cereal plant cell, plant or seed comprising a nucleotide sequence encoding a maltogenic alpha-amylase or the use of such transgenic plants in making a baked product.

The Examiner statement that the inventions are not related is also incorrect. Claims 23-37 relate to transgenic cereal plant cells, plants and seeds encoding a maltogenic alpha-amylase. Claims 38-42 relate to the use of transgenic cereal plants. Thus, contrary to the Examiner's assertion, the invention groups are related as each of the invention groups relate to transgenic cereal plants.

Under the standards set forth above, Applicant submits that the restriction requirement imposed in the Office Action is plainly improper.

The Examiner is hereby invited to contact the undersigned by telephone if there are any questions concerning this response or application.

Respectfully submitted,

Date: January 14, 2003

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